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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

NGUYEN, HUY D

ART UNIT	PAPER NUMBER
2681	14

DATE MAILED: 05/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/679,816

Applicant(s)

SAKAKURA, TAKASHI

Examiner

Huy D Nguyen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 April 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 12-16 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2,3,6 and 7 is/are allowed.
- 6) ☒ Claim(s) 1,4,5 and 8-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:  
  
Invention I: Claims 1-11.  
  
Invention II: Claims 12-16.
2. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed. The subcombination has separate utility such as controlling direct communication between the wireless terminal and the destination wireless terminal.
3. During a telephone conversation with attorney Clint Gerdine (Registration No. 41,035) on 05/21/2004 a provisional election was made to prosecute the invention I, claims 1-11. Affirmation of this election must be made by applicant in replying to this Office action. Claims 12-16 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 and recites the limitation "the destination wireless terminal" in lines 9, 10, and 12. There is insufficient antecedent basis for this limitation in the claim.

Claim 1 and recites the limitation "the wireless terminal" in lines 10 and 11. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 4-5, 8, 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kingdon et al. (U.S. Patent No. 6,138,003).

Regarding claims 1, 4-5, 8, Kingdon et al. teaches a wireless terminal communication method in a network, the network comprising, a plurality of wireless terminals (col. 3, lines 59-60), and a terminal location database (e.g., HLR 265 – col. 5, line 52; Fig. 2) for controlling the position information of the wireless terminals, the wireless terminal communication method comprises the steps of: inquiring to the terminal location database by a wireless terminal (e.g.,

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agency 280, taxi, police) for a position information of a destination mobile wireless terminal (e.g., MS 200) of the wireless terminal (col. 6, lines 30-37); and communicating with the destination wireless terminal to share data (e.g., provide location service for MS-requested positioning – col. 5, line 66) between the wireless terminal and the destination wireless terminal when the wireless terminal has received the position information of the destination wireless terminal from the terminal location database. Even though Kingdon et al. does not clearly teach whether agency 280 is mobile or not, it would have been obvious to one of ordinary skill in the art at the time of the invention to apply the concept regardless the agency 280 is mobile or not to enhance system flexibility and capability.

Regarding claim 10, Kingdon et al. teaches the wireless terminal communication method as defined in claim 8, further comprising: notifying to an other terminal location database (e.g., VLR) who can respond to the inquiry after the terminal location database receives an inquiry regarding a relevant information from the wireless terminal; and wherein the wireless terminal makes an inquiry to the other terminal location database based on this notification of the position of the other terminal location database (col. 5, lines 48-58).

Regarding claim 11, Kingdon et al. teaches the wireless terminal communication method as defined in claim 1, wherein the terminal location database refers and replies to the inquiring step the position information of the wireless terminals controlled by the cellular phone network (col. 4, lines 55-56).

8. Claim 9 rejected under 35 U.S.C. 103(a) as being unpatentable over Kingdon et al. (U.S. Patent No. 6,138,003) in view of O'Neill, Jr. (U.S. Patent No. 6,069,588).

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Regarding claim 9, Kingdon et al. teaches the claimed invention except for the ad hoc interface. O'Neill, Jr. teaches the interface for Ad Hoc (col. 6, lines 59-65). It would have been obvious to one of ordinary skill in the art to apply the teaching of O'Neill, Jr. to the teaching of Kingdon et al. to enhance system capability by providing universal radio interface in the 2.45 GHz frequency band that enables communicating wirelessly via short-range network.

*Allowable Subject Matter*

9. Claim 2 has been rewritten in the independent form including all the limitations of the base claim. Therefore, claim 2 is now allowable with the same reason set forth in the previous office action (paper No. 7).

Claims 3, 6-7 have been allowed previously.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huy D Nguyen whose telephone number is 703-305-3283. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Erika A Gary can be reached on 703-308-0123. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

in

  
ERIKA GABY  
PATENT EXAMINER